

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
Paul J. Rankin)
Serial No.: 09/833,471) Group Art Unit: 2154
Filed: April 12, 2001) Examiner: Ashokkumar B. Patel
For: COMMUNICATIONS SYSTEM) **Board of Patent Appeals and**
) **Interferences**
)

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

In support of the Notice of Appeal filed on December 29, 2006, and pursuant to 37 C.F.R. § 41.37, Appellants present their appeal brief in the above-captioned application.

This is an appeal to the Board of Patent Appeals and Interferences from the Examiner's final rejection of claims 1-17 in the Final Office Action dated October 3, 2006. The appealed claims are set forth in the attached Claims Appendix.

1. Real Party in Interest

This application is assigned to U.S. Philips Corporation, the real party in interest.

2. Related Appeals and Interferences

There are no other appeals or interferences which would directly affect, be directly affected, or have a bearing on the instant appeal.

3. Status of the Claims

Claims 1-17 have been rejected. The final rejection of claims 1-17 is being appealed.

4. Status of Amendments

All amendments submitted by Appellant have been entered.

5. Summary of Claimed Subject Matter

The present invention, recited in independent claim 1, relates to a system of at least one server (10) coupled to a plurality of user stations (12) via a first network (14) where the user stations (12) are arranged to receive information from the at least one server (10) over the first network (14). (See Specification, p. 5, ll. 10 – 14; Fig. 1). The at least one server (10) possesses at least one storage means (16) coupled thereto, the storage means (16) containing data representing characteristic behavior of users associated with the user station (12). (See Id., p. 5, ll. 15 – 18; Fig. 1). This data is automatically acquired by the at least one server (10) in response to user activities at the user station (12) and is placed in the profile database of the storage means (16), the data being identifiable by the network address(es) of the user station (12). (See Id., p. 5, ll. 15 – 23). A portable communications device (18), communicatively coupled over device link (24) to at least one server (22) of a second network, also couples to the user station (12). (See Id., p. 5, ll. 24 – 32). Once user station (12) and portable device (18) are coupled over link (20), the user may automatically acquire data from the profile database via portable communication device (18). (See Id., p. 5, l. 30 – p. 6, l. 8). Thus, by utilizing the communicative links of the portable communication device (18), data link (24), second network server (22), link (26) and server (10), the user station (12) accesses the profile database without the use of link (14). (See

Id., p. 5, l. 28 – p. 6, l. 8, Fig. 1).

The present invention, recited in independent claim 12, relates to a method for providing a profile database containing data representing a characteristic behavior of an associated user via at least one server (10). (See Id., p. 5, ll. 16-18). The data is identifiable by the network address or addresses of the user's terminal (12) when stored and is automatically acquired in response to an activity of the user associated with the terminal (12). (See Id., p. 5, ll. 16 – 23). The method further provides data being automatically acquired by the user terminal (12) via a portable communications device (18), the device coupled with the terminal (12) and connectable to the at least one server (10) via connection with at least one server (22) on a second network (24). (See Id., p. 5, l. 28 – p. 6, l. 8, Fig. 1).

The present invention, recited in independent claim 14, relates to a communication system that includes a plurality of user stations (12) coupled via their respective terminals to at least one server (10) over a first network (14), the terminals arranged to receive information stored on a storage memory (16) of the server (10). (See Id., p. 5, ll. 10 – 23, Fig. 1). At least one portable communication device (18) is communicatively coupled to a station of the plurality of user stations (12) (See Id., p. 5, ll. 24 – 28). The terminal of the station (12) stores data, acquired in response to the user's activity at the terminal (12), together with the terminal network address into a profile database of the server (10) via the portable communications device (18) once a second network connection is established. (See Id., p. 5, l. 28 – p. 6, l. 8, Fig. 1).

6. Grounds of Rejection to be Reviewed on Appeal

I. Whether the applicant's declaration under 37 CFR §1.131 was insufficient to establish diligence to the filing of the international application from which the present application claims priority, thereby eliminating U.S. Pat. Pub. No. 2002/0022453 to Balog et al., (Balog) as prior art.

II. Whether claims 1-3, 5, 6 and 10-17 are unpatentable under 35 U.S.C. § 103(a) over U.S. Pat. Pub. No. 2002/0022453 (Balog) in view of Middleton et al., U.S. Pat. No. 6,393,407 (Middleton).

III. Whether claims 4 and 7-9 are unpatentable under 35 U.S.C. § 103(a) over U.S. Pat. Pub. No. 2002/0022453 (Balog) in view of Middleton et al., U.S. Pat. No. 6,393,407

(Middleton) in further view of Trost et al., U.S. Pat. Pub. No. 2002/0151275 (Trost).

7. Argument

- I. The Examiner Erred In Holding The Applicant's Declaration Under 37 CFR §1.131 Is Insufficient To Establish Diligence To The Filing of The International Application From Which This Application Claims Priority.

A. The Examiner's Rejection

In response to the Examiner's Office Action mailed on April 11, 2006, Applicant submitted a declaration under 37 C.F.R. §1.131 with supporting documentation to show Applicant's date of invention prior to the effective date of the Balog reference. The Applicant showed diligence from November 5, 1999 through the filing date of April 15, 2000 of the international application from which the present application claims priority. The applicant's invention date of at least November 5, 1999, is prior to March 31, 2000, the effective date of Balog, thereby disqualifying Balog as prior art.

The supporting documentation included the disclosed invention within "Philips Research Laboratories – Proposal for a Patent Application" dated November 5, 1999 and stamped received on November 10, 1999. (See Rankin, Paul, Declaration Under 37 C.F.R. §1.131, 06/27/2006, Evidence, p. 1). Applicant submitted the document for diligent processing by the Philips patent department. Despite patent department backlog, the patent application was diligently filed on April 15, 2000.

In the Final Office Action, the Examiner states that the declaration was not analyzed in detail, yet claims there is no allegation or evidence showing Applicant's diligence continued until the invention was actually reduced to practice or until the filing of the international application on April 15, 2000. (See 10/03/06 Office Action, p. 2, ¶¶ 3-4).

B. The Examiner's Error Under 37 CFR §1.131

Applicant respectfully submits that Examiner's admission as to the Examiner's failure to properly examine the declaration under 37 C.F.R. §1.131 indicates a clear error on the part of the Examiner in properly reviewing the Applicant's submission. Had the Examiner taken the time to analyze the declaration "in detail," the Examiner would find that the declaration meets all the requirements of 37 C.F.R. §1.131.

The Declaration under 37 C.F.R. §1.131 states the Applicant's intention in filing a patent application upon submission of the written invention disclosure on November 5, 1999. (See Rankin, Paul, Declaration Under 37 C.F.R. §1.131, 06/27/2006, p. 1). The declaration further states there was a delay because of a backlog in the patent department of Koninklijke Philips Electronics N.V., but the application was still filed on April 15, 2000. (See *Id.*). Therefore, the declaration that Philips' patent department exercised due diligence, despite the patent department backlog, is sufficient evidence of reasonable diligence in constructive reduction to practice.

Under 37 CFR §1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice. (See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947), MPEP §715.07(a)). An applicant must account for the entire period during which diligence is required. (See *Gould v. Schawlow*, 363 F.2d 908, 919 (CCPA 1966). The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. (See *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975). Reasonable diligence is established if the attorney worked reasonably hard on the application during the continuous critical period. (See *Bey v. Kollonitsch*, 806 F.2d 1024, 1027 (Fed. Cir. 1986)). If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient. (See *Id.*, at 1028). Work on a related case(s) that contributed substantially to the ultimate preparation of an application can be credited as diligence. (See *Id.*).

In *Bey*, the patent department experienced a backlog of applications causing a

delay in the constructive reduction to practice of the plaintiff's invention. (See Id. At 1029). The Court of Appeals for the Federal Circuit held that the plaintiff established reasonable diligence throughout the critical period prior to constructive reduction to practice, despite the patent attorney's backlog in patent applications. (See Id., at 1029). Here, Applicant's declaration recites: "The inventor submitted written invention disclosure materials to the patent department of Koninklijke Philips Electronics N.V. with the intention of filing for patent protection." (See Rankin, Paul, Declaration Under 37 C.F.R. §1.131, 06/27/2006, p. 1). The declaration further recites: "It is believed that the application was prepared and filed on April 15, 2000 due to the backlog in the patent department of Koninklijke Philips Electronics N.V." (See Id.). Like the facts in Bey, the Applicant's disclosure was delayed by the backlog within the patent department of Koninklijke Philips Electronics N.V. Thus, the large amount of applications requiring attention by patent attorneys at Koninklijke Philips Electronics N.V. shows that the attorney was diligent in filing the application based on the inventor's submitted disclosure.

Therefore, Applicant respectfully submits that the declaration under 37 C.F.R. §1.131 provides sufficient evidence establishing diligence by the patent attorney(ies) of Koninklijke Philips Electronics N.V. for the duration of the critical period from November 5th, 1999 to April 15th, 2000. Thus, the Examiner's claim that the declaration fails to evidence diligence in constructive reduction to practice is in error and should be withdrawn.

Therefore, because the Applicant has provided sufficient evidence of diligence in constructive reduction to practice, the Applicant's date of invention of at least, November 5, 2000, precedes the effective date of the Balog reference, March 31, 2000. Applicant respectfully submits that the Balog reference is not prior art and the Examiner cannot use the reference as a source of rejection for the claimed invention. In light of the above, the rejections of claims 1-3, 5, 6 and 10-17 under 35 U.S.C. §103(a) as being unpatentable over Balog in view of Middleton and the rejections of claims 4 and 7-9 under 35 U.S.C. §103(a) as being unpatentable over Balog in view of Middleton in further view of Trost must be withdrawn.

II. The Rejection of Claims 1-3, 5, 6, and 10-17 Under 35 U.S.C. § 103(a) as Being Unpatentable Over U.S. Pat. Pub. No. 2002/0022453 (Balog) in view of Middleton et al., U.S. Pat. No. 6,393,407 (Middleton) Should Be Reversed.

A. The Examiner's Rejection

In the Final Office Action, the Examiner rejected claims 1-3, 5, 6, and 10-17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. Pub. No. 2002/0022453 (Balog) in view of Middleton et al., U.S. Pat. No. 6,393,407 (Middleton). (See 10/03/06 Office Action, p. 2, ¶ 6).

Balog discloses a system for dynamic protocol selection and routing of content to mobile devices. A plurality of mobile devices is communicatively coupled to each other via BLUETOOTH technology and communicating content to each other. (See Balog, p. 4, ¶ [0041]; Figs. 1, 7). The content includes a plurality of data types and is delivered from a single service provider (12) to at least one of the mobile devices (16) depending on the characteristics of the data and the characteristics of the device (16). (See *Id.*, p. 3, ¶¶ [0031] –[0034]). According to Balog, mobile devices (42), (44), (48) and (50), when within range of each other, can form a separate ad-hoc network with one or more of the users in that network acting as service providers. (See *Id.*, p. 4, ¶ [0040]; Fig. 6). However, in order for the system of Balog to compile a global profile (28) that can deliver content to a plurality of mobile devices (52), (54) and (56), at least one of the mobile devices must always remain connected to the single service provider (12)/(42). (See *Id.*, p. 4, ¶ [0041]; Fig. 1, 6, 7).

Middleton teaches a system that collects data, stores the data locally and then sends that data to another server that will store the local data. The system provides for applets (44) to be downloaded with a webpage (40) capable of logging the user's interactions on the webpage (40). (See Middleton, col. 6, ll. 31-34). According to Middleton, applets (44) of the webpage (16) are downloaded from server (12a) to the client's local memory (24) over the communication media (14). (See *Id.*, col. 5, ll. 54-57; Fig. 1). The client computer (20a) sends the activity data to server (12b) via a "back channel" after leaving the present webpage (40). (See *Id.*, col. 5, ll. 54-57). The "back channel" is a second network connection exclusively between

the client computer (20a) and server (12b). (See Id., col. 5, ln. 54 - col. 6, ln. 11). The Middleton system requires that activity data be stored on the client computer before it can be received at the server (12b). (See Id., col. 4, ll. 60-64, col. 5, ll. 37-40, col. 6, ll. 41-44). Ultimately, Middleton discloses that the information stored on server (12b) may be used to tailor web page advertisements prior to the advertisement being loaded on the webpage (16). (See Id., col. 6, ll. 24-29, ll. 45-50).

B. The Cited Patents Do Not Disclose A System Wherin the User Terminal Is Configured To Perform The Automatic Acquisition Of Data For The Profile Databases, Said Data Being Transferred, For Storage In The Profile Database, To The At Least One Server Via Said Portable Communications Device Following Establishment Of A Connection Via Said Second Network As Recited In Claim 1.

The Examiner admits that Balog does not teach, “wherein the user terminal is configured to perform the automatic acquisition of data for the profile database, to the at least one server via said portable communications device following establishment of a connection via said second network.” (See 10/03/06 Office Action, p. 4, ll. 1-5). The system in Balog must always have at least one mobile unit connected with the server so that the server can compile a global profile. (See Balog, p. 4, ¶ [0041]; Fig. 1, 6, 7). Further, Balog neither teaches nor suggests the storing of data on a server following a subsequent connection to a mobile device coupled to a second network. (See Balog, Fig. 1, 6, 7).

The Examiner suggests that Middleton cures the deficiencies of Balog. Specifically, the Examiner states that Middleton teaches a “back channel” connection to server (12b) that is a second network connection, different from the network connection used to fetch the Web page (16) and download the applet (44). (See 10/03/06 Office Action, p. 4, ll. 15-19). Unlike the invention of claim 1, Middleton’s client computer (20a) sends locally stored activity data to server (12b) via a back-channel connection and does not transfer the activity data to server (12b) via another server or a portable communications device. (See Middleton, col. 5, ll. 54-57; Fig. 1). The Middleton reference lacks any description of automatically acquiring data from a client computer (20a) and transferring the data through a communications device to server (12b) via a second network connection. Middleton is limited to transferring data over a single back-channel connection, and never establishes a second network connection between client

computer (20a) and server (12b). Further, Middleton fails to teach a client computer (20a) configured to automatically acquire data upon the establishment of a second network connection and merely describes a computer that “flushes” data to the server (12b). (See Middleton, col. 6, ll. 6-11).

Thus, neither Balog, nor Middleton, either alone or in combination, disclose the cited recitation of claim 1. Accordingly, because claims 2-3, 5, 6, 10-11 and 16 depend from and, therefore, include all the limitations of claim 1, it is respectfully submitted that these claims are also allowable.

It is respectfully submitted that claims 12 and 14 include substantially the same limitations as recited in claim 1, and are therefore allowable for at least the same reasons cited above with respect to claim 1. Because claims 13, 15 and 17 depend from and therefore include all the limitations of claims 12 and 14 respectively, these claims should also be allowable.

C. The Examiner Fails to Make A Prima Facie Case of Obviousness Under 35 U.S.C. § 103(a) Because There Is No Motivation Or Suggestion To Combine The Cited References As Required And Therefore The Rejection Must Be Withdrawn.

The Examiner claims that it would have been obvious to combine the back-channel communications of Middleton with the plurality of mobile devices connected to the server as described in Balog. (See 10/03/06 Office Action, p. 5, ll. 8-15). The Examiner suggests that the client computer (20a) can transfer its activity data through the back-channel via another user’s blue-tooth device and the server (12b). (See Id.). It is respectfully submitted that the Middleton reference neither motivates nor suggests one skilled in the art to employ multiple devices between the client computer (20a) and the server (12b).

Adding additional device connections to the back-channel connection of the system taught in Middleton will increase the time for data to transfer from the client computer (20a) to the server (12b). Those skilled in the art may recognize that by adding network components in series causes the data transfer from one network device (i.e. the client computer

20a) to a next network device (i.e. the mobile devices (16) described in Balog) to slow down and thus increase the transfer time of that data from the origin to the ultimate destination (i.e. the server (12b)). Those skilled in the art would also understand that a back-channel connection is a low-speed, less-optimal network communication, and by adding additional devices connected via the back-channel connection would only further slow the less-optimal network communication.

Here, the Examiner's proposal to increase the amount of network devices present over the back-channel connection would burden the data transfer capabilities of the Middleton system. Because the system of Middleton seeks to anticipate the type of advertisements to send users who are viewing a web page, there is no suggestion or motivation in the Middleton reference to increase the time between when advertisers view user activity data and tailor advertisements on a web page in response to that received data. By combining Middleton with Balog, the Middleton system would function in a more inefficient manner than in its uncombined state, and thus one skilled in the art would not seek to further limit Middleton by combining its advertising system with the distributed mobile network of Balog.

Furthermore, it is respectfully submitted that in rejecting claims under 35 U.S.C. §103(a), the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. (See *In re Oetiker*, 977 F. 2d 1443, 1445, 24 U.S.P.Q. 2d 1442, 1444 (Fed. Cir. 1992); see also *In re Piasecki*, 745 F. 2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984).) The Examiner can satisfy this burden by showing that some objective teaching in the prior art of knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. (*In re Fine*, 837 F. 2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).)

When determining obviousness, “[t]he factual inquiry whether to combine references must be thorough and searching.” (*In re Lee*, 277 F. 3d 1338, 1343, 61 U.S.P.Q. 1430, 1433 (Fed. Cir. 2002), citing *McGinley v. Franklin Sports, Inc.*, 262 F. 3d 1339, 1351-52, 60 U.S.P.Q. 2d 1001, 1008 (Fed. Cir. 2001).) “It must be based on objective evidence of record.” (*Id.*) “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” (*In re Dembiczak*, 175 F. 3d 994, 999, 50 U.S.P.Q. 2d 1614, 1617.) “Mere denials and conclusory statements, however, are not sufficient to establish a

genuine issue of material fact." (Dembiczak, 175 F. 3d at 1000, 50 U.S.P.Q. 2d at 1617, citing McElmurry v. Ark. Power & Light Co., 995 F. 2d 1576, 1578, 27 U.S.P.Q. 2d 1129, 1131 (Fed. Cir. 1993).)

The suggestion in the Office Action that the combinations of prior art references would be obvious to one having ordinary skill in the art is respectfully refuted. One may not utilize the teaching of the present application as a road map to pick and choose amongst prior art references for the purpose of attempting to arrive at the presently disclosed invention. The Federal Circuit has identified three possible sources for motivation to combine references including the nature of the problem to be solved, the teaching of the prior art, and the knowledge of persons of ordinary skill in the art. (See In re Rouffet, 149 F. 3d 1350, 1357, 47 U.S.P.Q. 2d 1453, 1457-58 (Fed. Cir. 1998).) There must be a specific principle that would motivate a skilled artisan, with no knowledge of the present invention, to combine the prior art as suggested in the Office Action. The use of hindsight in the selection of references is forbidden in comprising the case of obviousness. Lacking a motivation to combine references, a proper case of obviousness is not shown. (See In re Rouffet, 47 U.S.P.Q. 2d at 1458.)

The U.S. Court of Appeals for the Federal Circuit (the "Federal Circuit") restated the legal test applicable to rejections under 35 U.S.C. §103 (a) in the Rouffet holding. The Federal Circuit stated:

[V]irtually all [inventions] are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. Furthermore, rejecting parents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." To prevent the use of hindsight based on the invention to defeat patentability of the invention. This court requires the Examiner to show a motivation to combine the references that create the case of obviousness. The Board (of Appeals) did not, however, explain what specific understanding of technological principle within the knowledge of

one of ordinary skill in the art would have suggested the combination. ... To counter this potential weakness in the obviousness contract the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.

Rouffet, 47 U.S.P.Q. 2d at 1457-58 (citations omitted).

More recently, the Federal Circuit again dealt with what is required to show a motivation to combine references under 35 U. S. C. §103 (a). In this case the Court reversed the decision of the Board of Appeals, stating:

[R]ather than pointing to specific information in Holiday or Shapiro that suggest the combination..., the Board instead described in details the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other in combination with each other... described all of the limitations of the pending claims. Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the ... references, not does the Board make specific—or even inferential—findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any factual findings that might serve to support a proper analysis.

In re Dembiczak, 50U.S.P.Q. 2d 1614, 1618 (Fed. Cir. 1999) (citations omitted).

Thus, from both In re Rouffet and In re Dembiczak it is clear that the Federal Circuit requires a specific identification of a suggestion, motivation, or teaching why one of ordinary skill in the art would have been motivated to select the references and combine them.

The Examiner's reasoning for the motivation, namely, that those skilled in the art would have been motivated to combine Middleton with the other prior art, could only have been made with hindsight based on the teaching of the present disclosure. The Examiner's reasoning for the motivation for combining the references is nowhere recognized in the prior art nor does the Examiner attempt to make any showing that the art recognized such problems.

Where a feature is not shown or suggested in the prior art references themselves, the Federal Circuit has held that the skill in the art will rarely suffice to show the missing feature. (Al-Site Corp. v. VSI International Inc., 174 F. 3d 1308, 50 U.S.P.Q. 2d 1161 (Fed. Cir. 1999) (Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment.)

Thus, Applicants again respectfully submit that the Examiner has used impermissible hindsight to reject claims 1-3, 5, 6, and 10-17 under 35 U.S.C. §103 (a). As discussed above, the Federal Circuit in In re Rouffet stated that virtually all inventions are combinations of old element. Therefore an Examiner may often find every element of a claimed invention in the prior art. To prevent the use of hindsight based on the invention to defeat patentability of the invention, the Examiner is required to show a motivation to combine the references that create the case of obviousness. Applicants respectfully submit that the Examiner has not met this burden.

The mere fact that the prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of the modification. (See In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984); In re Laskowski, 871 F. 2d 115, 117 (Fed. Cir. 1989).)

The only suggestion that can be found anywhere for making these combinations appears to come from the present patent application itself.

In consideration of the use of improper hindsight for rendering a claim obvious in light of prior art, the Federal Circuit has stated that “to draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge is to use the invention as a template for its own reconstruction – an illogical and inappropriate process by which to determine patentability.” (Sensonics, Inc. v. Aerosonic Corp., 81F.3d 1566, 38 U.S.P.Q. 2d 1551 (Fed. Cir. 1996).) “To imbue one of ordinary skill in the art with knowledge of the invention ensued, when no prior art reference or references of record convey or suggest

that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against each teacher.” (In re Zurko, 111 F. 3d 887, 42 U.S.P.Q. 2d 1476 (Fed. Cir. 1997).) “A critical step in analyzing the patentability of claims pursuant to section 103 (a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field (cited reference omitted). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher (cited reference omitted).’” (In re Kotzab, 208 F. 3d 1352, 54 U.S.P.Q. 2d 1308 (Fed. Cir. 1997).)

Applicants respectfully maintain that there is no suggestion in the prior art references to make the combinations in the manner proposed by the Examiner to achieve the Applicants’ claimed invention.

Finally, the MPEP states: “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure.” (MPEP § 2143, citing In re Vaeck, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed. Cir. 1991).) “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination... Although a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or a motivation in the reference to do so.’” (MPEP § 2143.01(III), citing In re Mills, 916 F. 2d 680, 682, 16 U.S.P.Q. 2d 1430, 1432 (Fed. Cir. 1990) (emphasis original).) There is no such suggestion in either Balog or Middleton that would justify such a combination.

Therefore, it is respectfully submitted that in light of the state of the law as set forth by the Federal Circuit and the Examiner’s lack of specificity with regard to the motivation to combine the cited references, that none of the suggested combinations of prior art utilized to reject each of claims 1-3, 5, 6, and 10-17 finds proper motivation for combination. Further, since the Examiner’s rejections acknowledge that the prior art alone does not show the claimed

features, it is respectfully submitted that claims 1-3, 5, 6, and 10-17 are not obvious in light of the cited references.

III. The Rejection Of Claims 4 and 7-9 Under 35 U.S.C. § 103(a) As Being Unpatentable Over Balog In View Of Middleton In Further View Of Trost et al., U.S. Pat. Pub. No. 2002/0151275 (Trost) Should Be Reversed.

A. The Examiner's Rejection

In the Final Office Action, the Examiner rejected claims 4 and 7-9 under 35 U.S.C. § 103(a) as being unpatentable over Balog in view of Middleton in further view of Trost. (See 10/03/06 Office Action, p. 10, ¶ 7).

Trost describes a Bluetooth environment comprising a variety of devices communicating over Bluetooth radio frequency connections without interconnecting cables. (See Trost, p. 2, ¶ [0041]). The system of Trost teaches a standard interface for the transfer and reception of control and application data to and from a Bluetooth device. (See Id., ¶ [0044]). However, Trost only describes methods for selecting among several classifications of packets and discusses the transmission of a packet fragments between the layers of a Bluetooth device. (See Id., p. 3, ¶¶ [0057], [0060], p. 11, ¶¶ [0139], [0148]; Fig. 2a-c, 8, 15).

B. The Cited Patent Does Not Disclose A System Wherein the User Terminal Is Configured To Perform The Automatic Acquisition Of Data For The Profile Databases, Said Data Being Transferred, For Storage In The Profile Database, To The At Least One Server Via Said Portable Communications Device Following Establishment Of A Connection Via Said Second Network As Recited In Claim 1.

It is respectfully submitted that the Examiner's claim that Trost cures any of the deficiencies of Balog and Middleton with respect to Claim 1 is without merit. Specifically, Trost fails to teach, "wherein the user terminal is configured to perform the automatic acquisition of data for the profile database, to the at least one server via said portable communications device following establishment of a connection via said second network," as recited in claim 1. Trost does not teach or describe a profile database. Trost also fails to show the automatic acquisition of data for the profile database via a portable communications device following establishment of a connection via a second network. Trost only describes methods of packet transmission and selection amongst Bluetooth devices. (See Trost, p. 11, ¶ [0139]). Therefore, applicant respectfully submits that Trost does not cure any of the deficiencies of the Balog and Middleton

references with respect to claim 1.

Thus, neither Balog, Middleton, nor Trost either alone or in combination, disclose the recitation of claim 1. Accordingly, because claims 4 and 7-9 depend from and, therefore, include all the limitations of claim 1, it is respectfully submitted that these claims are also allowable.

8. Conclusions

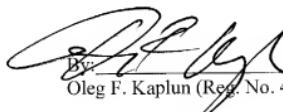
For the reasons set forth above, Appellants respectfully request that the Board reverse the Examiner's holding of an ineffective Declaration under 37 C.F.R. §1.131, reverse the Examiner's final rejections under 35 U.S.C. § 103(a) and indicate that claims 1-17 are allowable.

Please direct all future correspondence to:

Larry Liberchuk, Esq.
Senior IP Counsel

Philips Intellectual Property & Standards
P.O. Box 3001
Briarcliff Manor, NY 10510-8001
Phone: (914) 333-9618
Fax: (914) 332-0615
Email: larry.liberchuk@philips.com

Respectfully submitted,



Oleg F. Kaplun (Reg. No. 45,559)

Fay Kaplun & Marcin, LLP
150 Broadway, Suite 702
New York, NY 10038
Tel: (212) 619-6000

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CLAIMS APPENDIX

1. (Rejected) A communication system comprising:
 - at least one server and a plurality of user stations, the user stations include terminals arranged to receive information from the at least one server via a first network;
 - storage means, coupled to the at least one server, holding a profile database, the profile database containing data representing a characteristic behaviour of an associated user identifiable by the user's terminal network address or addresses, wherein the at least one server automatically acquires such data in response to an activity of the associated user and storing the same together with the associated user terminal network address or addresses in the profile database;
 - wherein the user station further includes a portable communications device coupled with said terminal and communicatively coupled to the at least one server via a second network,
 - wherein the user terminal is configured to perform the automatic acquisition of data for the profile database, said data being transferred, for storage in the profile database, to the at least one server via said portable communications device following establishment of a connection via said second network.
2. (Rejected) The system as claimed in Claim 1, wherein said portable communications device comprises a mobile telephone, said second network is a telecommunications network.
3. (Rejected) The system as claimed in Claim 1, where in the first network is the Internet and the user terminals comprise at least a display device coupled with processing means hosting an Internet browser and user-operable means for control of the same.
4. (Rejected) The system as claimed in Claim 3, wherein one or more of said terminals comprises a television receiver further configured to access and display data from the World Wide Web.
5. (Rejected) The system as claimed in Claim 1, wherein the coupling between the portable communications device and the respective user terminal comprises a wireless link.
6. (Rejected) The system as claimed in Claim 5, wherein data transfer via said wireless link

follows a predetermined set of message transfer protocols.

7. (Rejected) The system as claimed in Claim 1, wherein the portable communications device further comprises a buffer arranged to store data received from said the at least one server and addressed to the respective user terminal, and means for reading stored data from said buffer and sending said data on to the user terminal.

8. (Rejected) The system as claimed in Claim 7, wherein a said portable communication s device further comprises means configured to determine whether a respective user terminal is available to receive data from said the at least one server and, if so, to forward such data and, if not, to buffer such data until such time as either the respective user terminal becomes available or the buffer becomes full.

9. (Rejected) The system as claimed in Claim 7, wherein a said portable communications device further comprises means configured to determine whether said the at least one server is available to receive data from a respective user terminal and, if so, to forward such data and, if not, to buffer such data until such time as either the server becomes available or the buffer becomes full.

10. (Rejected) The system as claimed in Claim 1, wherein the or each said portable communications device further comprises the technical features of the respective user terminal.

11. (Rejected) The system as claimed in Claim 1, wherein the coupling with said user terminal is by wireless transmission therefrom, and the portable communications device means for receiving wireless transmissions from the terminal are further configured to receive additional data transmitted wirelessly from other sources.

12. (Rejected) A method of data communication for use in a networked communications system including at least one server and a plurality of user stations, the user stations include terminals which can receive information from the at least one server via a first network, the method comprising:

providing a profile database, via the at least one server, which profile database contains data representing a characteristic behaviour of an associated user identifiable by the user's terminal network address or addresses, the data being acquired automatically in response to an activity of the associated user and being stored together with the associated user terminal network address or addresses in the profile database;

wherein the user station further including a portable communications device coupled with said terminal and connectable to the at least one server via a second network, the user terminal performs the automatic acquisition of data for the profile database, said data being transferred, for storage in the profile database, to said the at least one server via said portable communications device following establishment of a connection via said second network.

13. (Rejected) A method as claimed in Claim 12, wherein the said portable communications device comprises a mobile telephone and stored access data for establishing connection comprises a telephone number for said mobile telephone.

14. (Rejected) A communication system comprising:
a server unit that includes at least one server;
coupled to said server unit, a plurality of user stations that each that each include a respective terminal arranged to receive, via a first network, information from the server unit;
coupled to said server unit, storage memory for holding a profile database; and
at least one portable communications device;
wherein a station, of plural user stations, is communicatively connected to a respective device of said at least one portable communication device; and
wherein the terminal, of the respective terminals, corresponding to said station is configured for automatically acquiring, in response to an activity of a user, data representing characteristic behaviour of said user, said system being configured to perform the storing of the acquired data, together with the user's terminal network address or addresses, into said profile database by transferring said acquired data to the server unit via said respective device following establishment of a connection via a second network.

15. (Rejected) The system of claim 14, wherein said system is further configured to perform

said transferring to make a sales solicitation.

16. (Rejected) The system of claim 1, wherein the transferring makes a sales solicitation.
17. (Rejected) The method of claim 14, wherein the transferring makes a sales solicitation.

EVIDENCE APPENDIX

Rankin, Paul, Declaration Under 37 C.F.R. 131, 06/27/2006, p. 1-2

RELATED PROCEEDING APPENDIX

No decisions have been rendered regarding the present appeal or any proceedings related thereto.